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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,392	01/02/2004	Manabu Saito	046601-5127	9164
9629	7590	05/05/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			MORRISON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/749,392	SAITO ET AL.	
	Examiner	Art Unit	
	Thomas A. Morrison	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 16-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01/02/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-15 in the reply filed on February 7, 2005 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, claim 1 recites "the reverse discharge path" in line 19. It is unclear which reverse discharge path is referred to in this claim. Is it the discharge path of each sheet discharge unit?

Regarding claim 4, it is unclear what is meant by the recited "which the height is different from one another" in lines 5-6.

Claim 5 recites that a discharge capacity of a sheet is variably set according to a sheet transporting speed of the processing device body in the plurality of sheet

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discharge units. It is unclear how the capacity is variably set according to transporting speed in the sheet discharge units.

Claim 6 recites that a discharge capacity of a sheet is variably set according to a sheet feeding amount of the processing device body in the plurality of sheet discharge units. It is unclear how the capacity is variably set according to the sheet feeding amount in the sheet discharge units.

Claim 7 recites that a discharge capacity of a sheet is variably set according to a sheet processing amount of the processing device body. It is unclear how the capacity is variably set according to the processing amount in the sheet discharge units.

Claim 9 recites the limitation "the discharge member" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, it is unclear what is meant by "upwardly withdrawn".

Regarding claim 12, it is unclear which reverse discharge path is referred to in line 19. Is it the reverse discharge path of each sheet discharge unit?

Regarding claim 13, it is unclear which reverse discharge path and which discharge port is referred to in this claim. For examination purposes, the discharge port and the reverse discharge path of claim 13 have been interpreted to be different from the recited discharge port and reverse discharge path set forth in claim 12.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 8-15, as best understood, are rejected under 35

U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,134,418 (Kato et al.). In particular, Kato et al. discloses all of the limitations of claims 1-3 and 8-15.

Regarding claim 1, Figs. 4 and 6 show a sheet discharge device (near 46) that is incorporated as a part of a processing device body (near 42) and discharges a sheet processed at a processing section (66) in the processing device body (near 42) toward a sheet stacking section (84a) disposed at an upper section of the processing device body (near 42), including

a unit receiving section (46) formed at the processing device body (near 42),

a plurality of sheet discharge units (82 of Fig. 4 and 82 of Fig. 6) each having a different specification (element 92 is different in Fig. 6) and being mounted to the unit receiving section (46) to be attached thereto and detached therefrom, each sheet discharge unit (82 of Fig. 4 and 82 of Fig. 6) having a normal discharge path (out of 46 and then up along 84a) directing toward the sheet stacking section (84a) and a reverse discharge path (switchback path back in the direction of 46) that is branched from the way of the normal discharge path (out of 46 and then up along 84a) to extend toward a direction of a reverse discharge and that communicates with a sheet transport path of an external unit (48) connectable to a side of the processing device body (near 42), and

a discharge port (near 46 on element 82) of the reverse discharge path is set to the same position in the plurality of sheet discharge units (discharge port out of 82 and into 46 is the same for Fig. 4 and Fig. 6).

Regarding claim 2, each of the sheet discharge units (82 of Fig. 4 and 82 of Fig. 6) is removable from the unit receiving section.

Regarding claim 3, Figs. 4 and 6 show that each of the sheet discharge units (82 of Fig. 4 and 82 of Fig. 6) is provided with a discharge member (discharge member 76 located near 88b) disposed proximate to an upper surface of the sheet stacking section (84a) provided at the upper section of the processing device body (near 42).

Regarding claim 8, Fig. 4 shows that a roller member (near 86a) is provided at least on a lower wall of the normal discharge path (out of 46 and along 84a).

Regarding claim 9, Figs. 4 and 6 shows that the discharge member (76) is mounted in the vicinity of a discharge port (i.e., a port is located near 86a that feeds out to 84a) of the normal discharge path. Also, the upper and lower wall faces of the reverse discharge path (switchback path back in the direction of 46) are formed not to block a linear reference surface (not shown) connecting a nipping section of the discharge member (76) and a lower edge of the discharge port (near 46 of element 82) of the reverse discharge path.

Regarding claim 10, Figs. 4 and 6 show that an upper wall of the reverse discharge path (switchback path back in the direction of 46) is upwardly withdrawn from an extending surface of an upper wall of the normal discharge path (out of 46 and then

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up along 84a). In particular, the reverse discharge path is below the part of the normal discharge path going out to 84a.

Regarding claim 11, Figs. 4 and 6 show that lower walls of the normal discharge path (out of 46 and then up along 84a) and the reverse discharge path (switchback path back in the direction of 46) are formed into an approximately v-shape for widening a space in the vicinity of a crossing section of the normal discharge path (out of 46 and then up along 84a) and the reverse discharge path (switchback path back in the direction of 46). See V-shape of location where normal and reverse discharge paths meet near 88a.

Regarding claim 12, Figs. 4 and 6 show a sheet processing device (80) including a sheet discharge device (rollers near 46) that is incorporated as a part of a processing device body (near 42) and discharges a sheet processed at a processing section (66) in the processing device body (near 42) toward a sheet stacking section (84a) disposed at an upper section of the processing device body (near 42), with a unit receiving section (46) formed at the processing device body (near 42),

a plurality of sheet discharge units (82 in Fig. 4 and 82 in Fig. 6) each having a different specification (92 is different in Fig. 6) and being mounted to the unit receiving section (46) to be attached thereto and detached therefrom, each sheet discharge unit having a normal discharge path (out of 46 and then up along 84a) directing toward the sheet stacking section (84a) and a reverse discharge path (switchback path back in the direction of 46) that is branched from the way of the normal discharge path to extend

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toward a direction of a reverse discharge and that communicates with a sheet transport path of an external unit (48) connectable to a side of the processing device body (near 42), and

a discharge port (near 46 on element 82) of the reverse discharge path is set to the same position in the plurality of sheet discharge units (discharge port out of 82 and into 46 is the same for Fig. 4 and Fig. 6).

Regarding claim 13, Figs. 4 and 6 show an external unit (48) is added to a discharge port (a discharge port located between 46 and 48) of a reverse discharge path (path connecting 46 to 48).

Regarding claim 14, Figs. 4 and 6 show that the external unit (48) is a duplex unit.

Regarding claim 15, the duplex unit (48) is an external unit that is a post-processing unit. In other words, the duplex unit acts on the sheet after one side of the sheet has been processed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. Regarding claim 4, Figs. 4 and 24 show different embodiments that have different heights between the sheet stacking sections and the discharge members of such embodiments. As such, providing discharge members at different heights is merely a matter of design choice within the skill of one of ordinary skill in the art.

5. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being obvious over Kato et al. as applied to claim 1 above, and further in view of U.S. Patent Publication No. 2003/0116911 (Kanai).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claims 5-7, Kato et al. discloses all of the limitations of these claims, except for the discharge capacity of a sheet variably set according to a sheet transporting speed, sheet feeding amount, or sheet processing amount of the processing device body in the plurality of sheet discharge units.

Kanai discloses that it is well known to make a discharge capacity of a sheet variably set according to any one of transporting speed, sheet feeding amount, or sheet processing amount of a processing apparatus in sheet discharge units (4). See, e.g., paragraphs [0069] – [0072] of Kanai. According to Kanai, different discharge units (4) having different heights can be provided to perform this capacity difference and this arrangement is advantageous, because the different discharge units (4) can be exchanged and yet similar control can be achieved. See paragraphs [0071]-[0072]. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the discharge units (82) of Kato et al. according to the teachings of Kanai, because such capacity change can be accomplished by exchanging different discharge units, while still achieving similar control, as taught by Kanai.

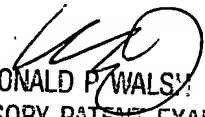
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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